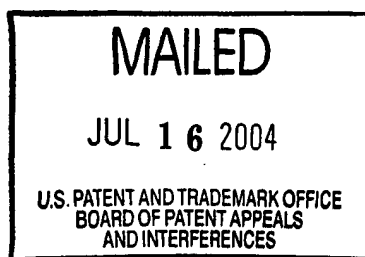


The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte SUSAN H. MATTHEWS

Appeal No. 2004-1435
Application 09/679,139

ON BRIEF

Before PAK, WARREN and WALTZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

We remand the application to the examiner for consideration and explanation of issues raised by the record. 37 CFR §1.196(a) (2003); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 1, Feb 2003; 1200-29 – 1200-30).

We observe that the initials of Conferee Supervisory Patent Examiner Tom Will does not appear on any of the three copies of the examiner's answer mailed January 29, 2004 (Paper No. 20). See MPEP § 1208 (8th ed., Rev. 1, Feb 2003; 1200-16).

In our remand entered September 29, 2003, in Appeal No. 2003-1647 in this application (Paper No. 17), we found with respect to the examiner's answer mailed March 11, 2003 (Paper No. 15), that

[t]he record shows that claims 7, 8, 10 and 16 were separately finally rejected over different combinations of references than finally rejected claims 1 through 3, 5, 6, 9,

11, 12, 14, 15 and 17 through 22 in the Office action of May 22, 2002 (Paper No. 9). The rejections were maintained in the advisory action of August 22, 2002 (Paper No. 11) [page 1],

and that

[t]he examiner sets forth in the answer only the statement of the ground of rejection applying to claims 1 through 3, 5, 6, 9, 11, 12, 14, 15 and 17 through 22, without supporting reasoning, citing no prior Office action in which such reasoning is found. [Page 2.]

Thus, we stated the following:

Accordingly, the examiner is required to take appropriate action consistent with current examining practice and procedure. . . to state in a supplemental answer *all* of the grounds of rejection advanced on appeal and either include a statement of *each* ground of rejection in the supplemental Office action or incorporate the statement of each ground of rejection by reference to a single prior Office action, with a view toward placing this application in condition for decision on appeal with respect to the issues presented. [*Id.*; emphasis supplied.]

We find that in the examiner's answer mailed January 29, 2004 (Paper No. 20) in response to our remand, the examiner again sets forth in the answer *only* the statement of the ground of rejection of claims 1 through 3, 5, 6, 9, 11, 12, 14, 15 and 17 through 22, without supporting reasoning or citing an prior Office action in which such reasoning is found, and does not set forth in any respect, the separate grounds of rejection involving appealed claims 7, 8, 10 and 16, or state that such grounds of rejection have been withdrawn. *See* MPEP § 1208 (8th ed., Rev. 1, Feb 2003; 1200-17).

Accordingly, the examiner is again required to take appropriate action consistent with current examining practice and procedure to state in a supplemental answer *all* of the grounds of rejection advanced on appeal and either include a statement of *each* ground of rejection in the supplemental Office action or incorporate the statement of each ground of rejection by reference to a single prior Office action, with a view toward placing this application in condition for decision on appeal with respect to the issues presented. Any supplemental answer should exhibit the initials of a conferee or conferees. MPEP § 1208 (8th ed., Rev. 1, Feb 2003). Appellant may file a reply brief responding to any supplemental answer prepared by the examiner in response to this remand. 37 CFR §1.193(b)(1) (2003); MPEP § 1208.03 (8th ed., Rev. 1, Feb 2003).

We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

This application, by virtue of its “special” status, requires immediate action. *See* MPEP § 708.01(D) (8th ed., Rev. 1, Feb 2003). It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal in this case. *See, e.g.*, MPEP § 1211 (8th ed., Rev. 1, Feb 2003).

Remanded

Cheryl C. Pelt

CHUNG K. PAK
Administrative Patent Judge


CHARLES E. WARREN

CHARLES F. WARREN
Administrative Patent Judge

Thomas A. Waltz
THOMAS A. WALTZ
Administrative Patent Judge

THOMAS A. WALTZ
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

Appeal No. 2004-1435
Application 09/679,139

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